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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD PFEIFER, GERHARD STENZEL, and
KATHLEEN WOLFRAM

Appeal 2009-003717
Application 10/601,996
Technology Center 2100

Decided: April 7, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

INVENTION

The invention on appeal relates to a user interface of a data processing system like websites, or application programs in which user action is tracked. (Spec. 1, ll. 4-6).

ILLUSTRATIVE CLAIM

1. A method for analyzing user behavior in a man-machine interface of a data processing system in which user action is tracked, characterized by the steps of:

(a) defining at least one success element associated with user navigation within said man-machine interface occurring during a user session,

(b) storing user navigation information from a plurality of said user sessions, said user navigation information being associated with said at least one success element and reflecting the user navigation behavior within said man-machine interface occurring during said plurality of said user sessions,

c) correlating, within said user navigation information, said at least one success element to user navigation behavior within said man-machine interface occurring during said plurality of said user sessions, and

d) performing a statistical analysis on a plurality of different sets of navigation information collected in respective different user sessions.

PRIOR ART

The Examiner relies upon the following reference as evidence:

Venkatesan US 6,928,474 B2 Aug. 9, 2005

THE REJECTIONS¹

1. The Examiner rejected claims 17-19 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.
2. The Examiner rejected claims 1-19 under 35 U.S.C. § 102(e) as anticipated by Venkatesan.

CLAIM GROUPING

Based upon Appellants' arguments in the Brief, we select claims 1 and 17 as representative claims for the anticipation rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

Issue 1: Under the written description requirement of § 112, first paragraph, did the Examiner err by finding that the subject matter of

¹ Appellants seek review of the Examiner's objection to the Specification. (Reply Br. 2). However, this is a petitionable matter to the Technology Center Director under 37 C.F.R. § 1.181 and thus is not within the jurisdiction of the Board.

“analyzing said user navigation information to identify differences between the behavior of users navigating within said web site during a first subset of said plurality of user web sessions and the behavior of users navigating within said web site during user web sessions which are not within said first subset of said plurality of user web sessions, said first subset of said plurality of user web sessions being user web sessions of said plurality of user web sessions for which at least one said success element as defined by said defining step is associated with user navigation of said interface provided by said web site during the respective user web session, said first subset being fewer than all said user web sessions,”

is not supported in the Specification? (Claim 17, *see* step (c)).

Issue 2: Under § 102, did the Examiner err by finding that Venkatesan fails to disclose or describe (a) defining a success element and (c) correlating the success element to user navigation behavior occurring during the plurality of “user sessions,” as required by the language of claim 1? (Claim 1, *see* steps (a) and (c)).

Issue 3: Under § 102, did the Examiner err by finding that Venkatesan discloses or describes defining a success element and identifying a first subset of user web sessions and the user navigation behaviors occurring during that first subset of user web sessions, as distinct from user web sessions not in the first subset and corresponding user navigation behaviors, the first subset being determined by the defined “success element?”(Claim 17, *see* step (c)).

PRINCIPLES OF LAW

112 first paragraph, Written Description

The test for written description is summarized in *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (internal quotation marks and citations omitted):

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in *haec verba* support for the claimed subject matter at issue. . . . Nonetheless, the disclosure must . . . convey with reasonable clarity to those skilled in the art that . . . [the inventor] was in possession of the invention. . . . Put another way, one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims. . . . That inquiry is a factual one and must be assessed on a case-by-case basis.

Anticipation under § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citations omitted).

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by the record:

Appellants' Specification

1. Appellants' Specification describes distinguishing between a first group and a second group of web sessions (not within the first group) and stores one of the groups of web sessions as a dataset (Data(Success element; location; Time)). (See Spec. pg. 10, ll. 10-11).

We further find that Appellants' Specification describes that the results described above are analyzed. For example, the Specification describes a statistical analysis that may be performed. (See pg. 11, ll. 3-6, 12-15; pg. 12, ll. 1-3, 18-26).

The Venkatesan Reference

2. Venkatesan discloses "collecting E-commerce and/or marketing related information such as the number of hits a web page containing a certain ad is receiving, discovering customer profiles, and the number of completed transactions in a given time period." (Col. 2, ll. 42-47).

3. Venkatesan discloses a technique for predicting future web navigation sequences. (Col. 2, ll. 20-24).

4. Venkatesan discloses element 420 which stores the monitored web navigation sequences performed by users visiting the web site while browsing the web pages. (Col. 6, ll. 32-36; Fig. 4).

5. Venkatesan discloses element 430 which analyzes each of the stored web navigation sequences to predict future web navigation patterns of the web site. (Col. 6, ll. 37-39; Fig. 4).

ANALYSIS

Issue 1

We decide the question of whether the Examiner erred in finding under the written description requirement of § 112 that step (c) of claim 17 is not supported in the Specification.

Based upon our review of the record, we agree with Appellants' arguments at pages 7-11 of the principal Brief. We find the portions of Appellants' Specification noted in FF 1 support the features recited in step (c) of claim 17. Although not expressed in these noted portions of the Specification in exactly corresponding terms, we find analyzing the user navigation information to note differences between the behavior of two different sets of users (FF 1) is sufficient to show possession, as of the filing date of the application, of the specific features recited in step (c) of claim 17. Contrary to the apparent view of the Examiner, there is no word for word or "*ipsis verbis*" requirement for the written description portion of 35 U.S.C. § 112, first paragraph. *See Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000) (The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement). Therefore, we reverse the Examiner's rejection of dependent claims 17-19 under the written description requirement of 35 U.S.C. § 112, first paragraph.

Issue 2

We decide the question of whether Venkatesan fails to disclose or describe (a) defining a success element and (c) correlating the success element to user navigation behavior occurring during the plurality of “user sessions,” as required by the language of claim 1. (*see* steps (a) and (c)).

At the outset, we note that the feature “success element” is, as admitted by Appellants, broadly defined and could “broadly encompass any of various things.” (App. Br. 17). As such, we broadly but reasonably construe the claimed “success element” as an indication of a favorable termination of attempts.

Appellants contend that Venkatesan does not disclose or suggest defining a “success element.” (App. Br. 17). However, given our aforementioned construction, we agree with the Examiner’s findings with respect to this feature. (Ans. 5-6). More particularly, as noted above, we find that Venkatesan discloses a number of completed transactions, i.e., the number of hits received by a web page containing a certain ad (a favorable termination of a search). (FF 2). Thus, we find that Venkatesan discloses a “success element” as claimed.

We note Appellants state that *correlating* “could encompass any of various forms of analysis which might somehow show the connection between the success element and certain user navigation behavior.” (App. Br. 17). In this light, we find that Venkatesan discloses that the success element (hits on a web site) is a variable in analyzing user navigation behavior (analyzing future web navigation sequences of users). (FF 3).

Therefore, we find that Venkatesan discloses a success element that correlates with user navigation behavior during a plurality of user sessions.

Based on the above, we find the Examiner did not err in rejecting representative claim 1. Accordingly, we affirm the Examiner's § 102 rejection of claim 1 and associated dependent claims 2-16 which fall therewith.

Issue 3

We decide the question of whether the Examiner erred by finding that Venkatesan discloses or describes defining a success element and identifying a first subset of user web sessions and the user navigation behaviors occurring during that first subset of user web sessions, as distinct from user web sessions not in the first subset and corresponding user navigation behaviors, the first subset being determined by the defined "success element." (Claim 17, *see* step (c)).

Appellants contend that the claim requires: (1) a success element be defined, and (2) the data is analyzed to identify differences between the navigation behavior occurring in user web sessions in a first subset of user web sessions and the navigation behavior occurring in user web sessions which are not within the first subset. (App. Br. 13-14).

We have found that Venkatesan discloses the argued feature of "defining a success element," as discussed *supra* regarding claim 1. Appellants further contend that Venkatesan does not distinguish between a successful website visitor and an unsuccessful web site visitor. (App. Br. 13). However, we agree with the Examiner's observation that these limitations are not recited in the claim, and we will not endeavor to read these argued limitations into claim 17. (Ans. 11).

We further agree with the Examiner that Venkatesan distinguishes between two types of users browsing a website. (Ans. 12-13). Venkatesan distinguishes between users on a website that visit a web page within the website containing a certain ad as opposed to those who do not visit the web page containing the ad. (FF 2).

With regards to Appellants' second contention, we find that Venkatesan discloses analyzing stored navigation sequences. The stored sequences are monitored web sessions performed by users visiting the web site while browsing the web pages. (FF 4-5)

For at least the aforementioned reasons, we find the Examiner did not err in determining that Venkatesan discloses the limitations recited in step (c) of claim 17. Accordingly, we sustain the Examiner's § 102 rejection of representative claim 17, as well as associated dependent claims 18 and 19 which fall therewith.

CONCLUSION

Based on the findings of facts and analysis above:

The Examiner erred in rejecting claims 17-19 under 35 U.S.C. § 112, first paragraph.

The Examiner did not err in rejecting claims 1-19 under 35 U.S.C. § 102(e).

ORDER

We reverse the Examiner's rejection of claims 17-19 under 35 U.S.C. § 112, first paragraph.

We sustain the Examiner's rejection of claims 1-19 under 35 U.S.C.

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§ 102(e).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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